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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,508	04/09/2001	Jack G. Winterowd	WEYE117204	6724
26389	7590	06/29/2004	EXAMINER	
CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<b>Application No.</b> 09/829,508	<b>Applicant(s)</b> WINTEROWD, JACK G.	
	<b>Examiner</b> Callie E. Shosho	<b>Art Unit</b> 1714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,9-13,15-22,24-28 and 33-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-6,9-13,15-22,24,26-28 and 33 is/are allowed.
- 6) ☒ Claim(s) 2,25 and 34-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. All outstanding rejections are overcome by applicants' amendment filed 4/9/04. Further, in light of the abandonment of co-pending 09/943,885, the double patenting rejections of record are withdrawn.

The new grounds of rejection as set forth below are necessitated by applicants' amendment and thus, the following action is final.

**Claim Rejections - 35 USC § 112**

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2, which depends on claim 1, recites paint composition "further comprising" at least one of a preservative, an optical brightener, a plasticizer, etc. while claim 1 has been amended to recite "consisting essentially of" transitional language. Thus, the scope of claim 2 is confusing because it is not clear how the paint can further "comprise" additional ingredients including those which would effect the basic and novel characteristics of the paint when the scope of the paint has already been limited to "consisting essentially of" as set forth in claim 1 especially given that the use of "consisting essentially of" claim language excludes the use of additional ingredients that effect the basic and novel characteristics of the paint composition.

Similar questions arise with respect to claim 25 which recites the same type of claim language as claim 2 and depends on claim 24 which also recites “consisting essentially of” claim language as found in claim 1.

**Claim Rejections - 35 USC § 103**

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 34-36 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman (U.S. 3,959,224) in view of Schwarte et al. (U.S. 5,601,880).

Coleman disclose water-based paint comprising latex, i.e. binder, obtained from alkyl (meth)acrylates, titanium dioxide, anionic surfactant, thickening agent such as hydroxyethylcellulose, and vegetable oil such as soybean oil, i.e. debonding agent (col.18, lines 53-55, col.19, lines 9-10 and 24, col.19, line 67-col.20, line 5, col.20, lines 9-10, 14-15, and 19-21, 25-26, and 31, and Table I).

The difference between Coleman and the present claimed invention is the requirement in the claims of polypropylene glycol.

Schwarte et al., which is drawn to water-based paint, disclose the use of polypropylene glycol in order to grind pigment and/or as a rheological control agent (col.11, lines 32-38).

In light of the motivation for using polypropylene glycol disclosed by Schwarte et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use

polypropylene glycol in the paint of Coleman in order to produce paint with desired pigment size and rheological properties, and thereby arrive at the claimed invention.

6. Claims 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman in view of Schwarte et al. as applied to claims 34-36 and 41-42 above, and further in view of Gruenwald et al. (U.S. 2,374,678).

The difference between Coleman in view of Schwarte et al. and the present claimed invention is the requirement in the claims of specific type of surfactant.

Gruenwald discloses surfactant that is derived from morpholine and long-chain, i.e. C<sub>12</sub>-C<sub>36</sub>, carboxylic acid (page 1, col.1, lines 35-45) wherein the motivation for using such surfactant is that it is inexpensive, imparts enhanced surface-active properties, and produces better pigment dispersions (page 1, col.1, lines 15-21 and page 2, col.2, lines 9-15).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use such surfactant in the paint of Coleman in order to produce a paint with superior surfactant properties and effective pigment dispersion, and thereby arrive at the claimed invention.

7. Claims 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman in view of Schwarte et al. as applied to claims 34-36 and 41-42 above, and further in view of Schall et al. (U.S. 6,013,721).

The difference between Coleman in view of Schwarte et al. and the present claimed invention is the requirement in the claims of specific type of binder.

Schall et al., which is drawn to water-based paint, disclose the use of binder with glass transition temperature of 10-40 °C such as butyl acrylate/methyl methacrylate copolymer (col.4, lines 8-11 and 56-59). The motivation for using such binder is to control the adhesion of paint to substrate.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use specific binder disclosed by Schall et al. in paint of Coleman in order to produce paint that effectively adheres to substrate, and thereby arrive at the claimed invention.

8. Claims 34-36 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bier (U.S. 4,792,357) in view of Schwarte et al. (U.S. 5,601,880).

Bier discloses water-based paint comprising hydroxyethylcellulose or carboxymethylcellulose, titanium dioxide, acrylic binder, silicone oil, i.e. debonding agent, and anionic surfactant (col.1, lines 8-9, col.3, lines 50 and 61, col.4, lines 19-20 and 54-56, col.5, lines 5 and 27-28).

The difference between Bier and the present claimed invention is the requirement in the claims of polypropylene glycol.

Schwarte et al., which is drawn to water-based paint, disclose the use of polypropylene glycol in order to grind pigment and/or as a rheological control agent (col.11, lines 32-38).

In light of the motivation for using polypropylene glycol disclosed by Schwarte et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use polypropylene glycol in the paint of Bier in order to produce paint with desired pigment size and rheological properties, and thereby arrive at the claimed invention.

9. Claims 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bier in view of Schwarte et al. as applied to claims 34-36 and 41 above, and further in view of Gruenwald et al. (U.S. 2,374,678).

The difference between Bier in view of Schwarte et al. and the present claimed invention is the requirement in the claims of specific type of surfactant.

Gruenwald disclose surfactant that is derived from morpholine and long-chain, i.e. C<sub>12</sub>-C<sub>36</sub>, carboxylic acid (page 1, col.1, lines 35-45) wherein the motivation for using such surfactant is that it is inexpensive, imparts enhanced surface-active properties, and produces better pigment dispersions (page 1, col.1, lines 15-21 and page 2, col.2, lines 9-15).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use such surfactant in the paint of Bier in order to produce a paint with superior surfactant properties and effective pigment dispersion, and thereby arrive at the claimed invention.

10. Claims 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bier in view of Schwarte et al. as applied to claims 34-36 and 41 above, and further in view of Schall et al. (U.S. 6,013,721).

The difference between Bier in view of Schwarte et al. and the present claimed invention is the requirement in the claims of specific type of binder.

Schall et al., which is drawn to water-based paint, disclose the use of binder with glass transition temperature of 10-40 °C such as butyl acrylate/methyl methacrylate copolymer (col.4,

lines 8-11 and 56-59). The motivation for using such binder is to control the adhesion of paint to substrate.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use specific binder disclosed by Schall et al. in paint of Bier in order to produce paint that effectively adheres to substrate, and thereby arrive at the claimed invention.

11. Claims 34-36, 39, and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kang et al. (U.S. 3,894,976) in view of Seiner (U.S. 3,951,899) and Schwarte et al. (U.S. 5,601,880).

Kang et al. discloses water-based paint comprising binder that is polyacrylate emulsion, titanium dioxide, anionic surfactant, hydroxyethylcellulose, and oil such as linseed oil that comprises portion of the binder. It is disclosed that one type of acrylic emulsion suitable for use in the paint is known under the tradename Rhoplex AC-61 which is well known, as found in Seiner (col.9, lines 28-29), as a emulsion of methylmethacrylate/butyl acrylate copolymer (col.6, line 60, col.7, lines 17, 34, 45-50, and 56-58, examples V and VII, and col.18, lines 46-58).

The difference between Kang et al. and the present claimed invention is the requirement in the claims of polypropylene glycol.

Schwarte et al., which is drawn to water-based paint, disclose the use of polypropylene glycol in order to grind pigment and/or as a rheological control agent (col.11, lines 32-38).

In light of the motivation for using polypropylene glycol disclosed by Schwarte et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use



polypropylene glycol in the paint of Kang et al. in order to produce paint with desired pigment size and rheological properties, and thereby arrive at the claimed invention.

12. Claims 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kang et al. in view of Seiner et al. and Schwarte et al. as applied to claims 34-36, 39, and 41-42 above, and further in view of Gruenwald et al. (U.S. 2,374,678).

The difference between Kang et al. in view of Seiner et al. and Schwarte et al. and the present claimed invention is the requirement in the claims of specific type of surfactant.

Gruenwald disclose surfactant that is derived from morpholine and long-chain, i.e. C<sub>12</sub>-C<sub>36</sub>, carboxylic acid (page 1, col.1, lines 35-45) wherein the motivation for using such surfactant is that it is inexpensive, imparts enhanced surface-active properties, and produces better pigment dispersions (page 1, col.1, lines 15-21 and page 2, col.2, lines 9-15).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use such surfactant in the paint of Kang et al. in order to produce a paint with superior surfactant properties and effective pigment dispersion, and thereby arrive at the claimed invention.

**Allowable Subject Matter**

13. Claims 1, 3-6, 9-13, 15-22, 24, 26-28, and 33 are allowable over the "closest" prior art Winterowd et al. (U.S. 6,608,131) for the following reasons.

Winterowd et al. disclose composition comprising 10-25% binder, i.e. acrylic latex possessing glass transition temperature of 20-40 °C and pH of 7-9, 2-30% vegetable oil such as

soybean oil, 1-4% surfactant that comprises long chain acid such as stearic acid, palmitic acid, and myristic acid and morpholine, 0.1-0.8% viscosity enhancing agent such as carboxymethylcellulose, 0.1-1% titanium dioxide, dispersing agent, preservative, and water.

However, applicants have amended all the claims to recite “consisting essentially of” transitional language. It is noted that “consisting essentially of” transitional language limits the scope of the paint composition to the specified ingredients and those that do not materially affect the basic and novel characteristics of the paint composition. However, in addition to the above ingredients, Winterowd et al. always requires that the composition contain wax, which materially affects the basic and novel characteristics of the composition, and thus, the composition of Winterowd et al. falls outside the scope of the present claims.

### **Conclusion**

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

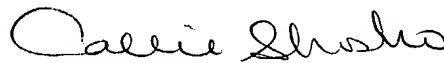
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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho  
Primary Examiner  
Art Unit 1714

CS  
6/24/04